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Application No. 10/674,971
Amendment dated December 7, 2006
Reply to Office Action of June 7, 2006

REMARKS

Applicant amended independent claims 29 and 39, and added new claims 54-57 to further define Applicant's invention. Support for new claims 54-57 can be found in the specification at least on page 15, lines 3-16; page 20, line 22 to page 21, line 4; and Figs. 6C, 9, 12A, 12B, 13B, and 14B. No new matter has been added.

In the Office Action, the Examiner rejected claims 29-38, 41, 50, and 51 on the ground of non-statutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,241,770 to Michelson; rejected claims 29-53 on the ground of non-statutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,485,517 to Michelson; provisionally rejected claims 29-38, 41, 50, and 51 on the ground of non-statutory obviousness-type double patenting as being unpatentable over the claims of copending application Serial No. 09/792,679; and provisionally rejected claims 29-53 on the ground of non-statutory obviousness-type double patenting as being unpatentable over the claims of copending application Serial No. 10/246,931.

Applicant is submitting concurrently with this reply a Terminal Disclaimer disclaiming the term of any patent granted on the present application that would extend beyond the term of U.S. Patent Nos. 6,241,770, 6,485,517, and any patent granted on application Serial Nos. 09/792,679 and 10/246,931, to overcome the Examiner's obviousness-type double patent rejections.

The Examiner rejected claims 29-53 under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent No. 6,033,438 to Bianchi ("Bianchi"). Applicant amended independent claim 29 to recite that the inserting step includes inserting the implant into the opening "with the lateral side facing one of the anterior and lateral aspects of the vertebral bodies" and to recite the step of "positioning the trailing end of the implant so that at least a portion of the trailing end of the implant between the medial side and the mid-longitudinal axis of the implant is seated on the peripheral rim of the densely compacted bone along the anatomical curvature of the adjacent vertebral bodies and does not substantially protrude from the spine." Applicant amended claim 39 to recite

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that the steps of inserting the first and second implants include inserting each of the implants into the at least one opening "with the lateral side facing one of the anterior and lateral aspects of the vertebral bodies" and to recite the step of "positioning the trailing end of each implant so that at least a portion of the trailing end of each implant between the medial side and the mid-longitudinal axis of the implant is seated on the peripheral rim of the densely compacted bone along the anatomical curvature of the adjacent vertebral bodies and does not substantially protrude from the spine." Support for this amendment is found in the Specification at least on page 15, lines 3-16; and Figs. 6C, 9, 12A, 12B, 13B, and 14B. No such structure or method is taught or suggested by Bianchi. It is submitted the rejection of claims 29 and 39 under 35 U.S.C. § 102(e) as being anticipated by Bianchi has been overcome.

In response to the remarks from Applicant's last amendment, the Examiner contends that "[a] definition of 'align'... does not necessitate that the corresponding surfaces conform. If the Applicant were to amend the independent claims so as to effectively replace 'is aligned' with --conforms--, then the examiner would be compelled to invoke a rejection under 35 U.S.C. 112, first paragraph, because 'majority' (e.g., claim 29, line 14) implies a range of greater than 50%, and such a range would be unsupported by the original disclosure." (Office Action, page 2, first paragraph). Applicant respectfully traverses the Examiner's contention. In Fig. 6C, Applicant discloses an implant in which the entire trailing end is aligned with the anatomical curvature of an adjacent vertebral body. Applicant submits that one of ordinary skill in the art would appreciate that Fig. 6C also shows an implant in which a majority of the trailing end is aligned with the anatomical curvature of an adjacent vertebral body. Similarly, one of ordinary skill in the art would appreciate that Fig. 6C also shows an implant in which a majority of the trailing end conforms to the anatomical curvature of an adjacent vertebral body. Nevertheless, Applicant has amended the claims in order to expedite prosecution of this application, and preserves the right to pursue without prejudice the cancelled subject matter in a future continuation application.

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Applicant submits that independent claims 29 and 39 are patentable and that dependent claims 30-38 and 40-57 dependent from independent claims 29 or 39, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

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